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REMARKS

Claims 1-65 are pending in the present Application. The pending claims have been presented for the Examiner's convenience. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-65 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 4,965,337 to Peters. In particular the Examiner has acknowledged that Peters does not teach the instantly claimed volatile species concentration, the reactive end group concentration, the weight average molecular weight of the polyetherimide sulfone, or a polyimide sulfone essentially free of benzylic protons. Despite the reference's failure to teach these claim limitations the Examiner has asserted "that the polyetherimide taught by Peters would possess the claimed properties or characteristics since they are of the same or similar identity." (Office Action, page 4) Applicants respectfully traverse this rejection.

Peters' entire teaching with regard to making the polyetherimide sulfone can be found in Col. 6, lines 3-31 and in the Examples. Interestingly, Peters does not teach or suggest several key aspects of the process that are required to produce the polyimide sulfone claimed in the pending application. Notably, Peters does not teach or suggest analyzing the reaction product for residual amine or anhydride end groups or the addition of additional monomer to keep the total amine and anhydride end group concentration below 20 meq/kg of resin, as is instantly claimed. Similarly, Peters does not teach or suggest methods for obtaining a product with a volatile content below 500 ppm. Applicants believe that without some sort of teaching in Peters as to how to obtain the instantly claimed polyimide sulfone the instantly claimed polyimide sulfone cannot be said to be obvious in view of Peters.

As shown in the Examples of the pending application, particularly Examples 5 and 6, the polyimide sulfone must meet both the volatiles limitation and the reactive end group limitation to avoid silver streaking and splay upon injection molding. As Peters contains no discussion of these injection molding phenomenon, Peters clearly cannot contain motivation

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as to overcome them. Therefore Peters contains no suggestion of the instantly claimed polyimide sulfones or the methods of producing them.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness because Peters does not disclose all elements of the instant claims, does not disclose any suggestion or incentive to modify the disclosed method of making the polyimide sulfone or any expectation of success. Accordingly, Applicants respectfully request withdrawal of the rejection.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

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If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862.

Respectfully submitted,

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